

## **REMARKS**

Applicants respectfully request reconsideration of the application including consideration and allowance of claims 4, 6-13 and 16 that are pending in the above-identified patent application. Claims 5, 14, 15 and 17-23 stand withdrawn from consideration. Claim 12 is canceled by this amendment. Applicants have amended claim 4. No new matter has been added by the claim amendments. Support for the amendment to claim 4 is found in paragraph 27 of the specification and FIG. 1.

At page 2 of the Office Action, the Examiner rejected claims 4, 6, 7, 11, 12 and 16 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 561,217 to Freyne (“Freyne”). Applicants traverse this rejection. Claim 4 as amended recites a horse shoe comprising a first part for coupling to a bottom of a horse’s hoof, the first part being formed from a material exhibiting a first amount of resiliency, the first part having an interior edge and a peripheral edge; and a second part extending from the first part to overly a sole portion of the horse’s hoof, the second part being formed from a material exhibiting a second amount of resiliency, wherein the second amount of resiliency is greater than the first amount of resiliency, **the second part disposed between said first part and the hoof** along said interior edge of said first part, only a portion of said second part extending from said interior edge to said peripheral edge of said first part. Freyne teaches a rubber ground-contacting part for enhanced traction (col. 1 lines 43-51). Unlike the presently claimed invention, Freyne discloses a first metallic part C and a second rubber part A wherein the first metallic part C is disposed between said second rubber part A and the hoof of a horse. Applicants respectfully submit that the Freyne reference fails to disclose each and every feature of the invention recited in claim 4. Thus, claim 4 as amended is not anticipated and is therefore allowable over Freyne. Claims 6, 7, 11, 12 and 16 are likewise allowable by virtue of their dependency on allowable claim 4.

At page 2 of the Office Action, the Examiner rejected claims 4 and 8 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,490,536 to Hourlier (“Hourlier”). Applicants traverse this rejection. Claim 4 as amended requires the second, more resilient part to be disposed between the less resilient, first ground-facing part and the hoof. Conversely, Hourlier teaches and discloses employing a second, more resilient part as the

ground-facing part and the first, less resilient part disposed between the second part and the hoof (Fig. 2; col. 2, lines 30-31). Applicants respectfully submit that the Hourlier reference fails to disclose each and every feature of the invention recited in claim 4. Thus, claim 4 as amended is not anticipated and is therefore allowable over Hourlier. Claim 8 is likewise allowable by virtue of its dependency on allowable claim 4.

At page 3 of the Office Action, the Examiner rejected claims 4 and 9 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,513,915 to Sherman (“Sherman”). Applicants traverse this rejection. Claim 4 as amended recites a horse shoe comprising a first part for coupling to a bottom of a horse’s hoof, the first part being formed from a material exhibiting a first amount of resiliency, the first part having an interior edge and a peripheral edge; and a second part extending from the first part to overly a sole portion of the horse’s hoof, the second part being formed from a material exhibiting a second amount of resiliency, wherein the second amount of resiliency is greater than the first amount of resiliency, the second part disposed between said first part and the hoof along said interior edge of said first part, only a portion of said second part extending from said interior edge to said peripheral edge of said first part. Sherman discloses a second part 11A disposed between a first part 32 and a hoof of a horse wherein the entirety of the second part extends from the interior edge to the peripheral edge of the first part 32. Applicants respectfully submit that the Sherman reference fails to disclose each and every feature of the invention recited in claim 4. Thus, claim 4 as amended is not anticipated and is therefore allowable over Sherman. Claim 9 is likewise allowable by virtue of its dependency on allowable claim 4.

At page 3 of the Office Action, the Examiner rejected claims 4, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,892,150 to Thoman (“Thoman”). Applicants traverse this rejection. As pointed out by the examiner, Thoman is directed to a horse shoe having a first part 36 and an inwardly-extending second part 24 in the form of a plurality of leaves. In Thoman, the second part 24 is not disposed between the first part and the hoof of a horse. As noted hereinabove, claim 4 as amended requires the second part to be disposed between the first part and the hoof of a horse. Since Thoman neither teaches nor suggests providing a second part disposed between the first part and the hoof of a horse, applicants respectfully submit that the Thoman reference fails to disclose each and every

feature of the invention recited in claim 4. Thus, claim 4 as amended is not anticipated and is therefore allowable over Thoman. Claims 9 and 10 are likewise allowable by virtue of their dependency on allowable claim 4.

At page 3 of the Office Action, the Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Thoman in view of U.S. Patent No. 6,467,548 to Rynningen (“Rynningen”). Applicants respectfully traverse the Examiner’s rejection. Claim 13 is dependent on amended claim 4, which as set forth hereinabove is patentable over the Thoman reference. A skilled artisan viewing the Thoman reference would not be motivated to look to the Rynningen reference to achieve the invention claimed in claim 13. Therefore, the combination of references by the Examiner is not permitted. Furthermore, combining the Thoman reference with Rynningen would not result in the invention claimed in claim 13. Accordingly, applicants respectfully request that the Examiner withdraw the § 103(a) rejection of claim 13 of the instant application.

Given the allowability of claim 4, which the examiner has acknowledged is generic, the applicants are entitled to consideration of the remaining claims

In view of the foregoing, applicants submit that the instant claims are in condition for allowance. Early and favorable action is earnestly solicited.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 11-0223 therefore.

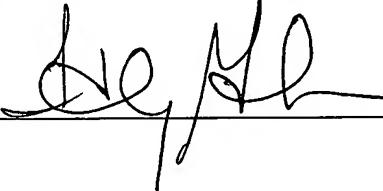
Respectfully submitted

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#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal service as first class mail, in a postage prepaid envelope, addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 15, 2004.

Dated October 15, 2004 Signed  Print Name Timothy X. Gibson